

Remarks/Arguments

The present amendment is made in response to the Office Action dated November 7, 2003 and identified as Paper No. 13. Claims 1-4, 6-12, and 14 remain pending in the application.

In the Action, the Examiner rejected claim 1 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,018,616 to Sugahara et al. ("*Sugahara*") in view of U.S. Patent No. 3,793,055 to Shodai et al. ("*Shodai*") or U.S. Patent No. 3,622,732 to Ishida et al. ("*Ishida*"). Claim 7 was rejected under 35 U.S.C. § 103(a) as obvious over *Sugahara* and *Shodai* or *Ishida* in further view of U.S. Patent No. 4,291,154 to Blount ("*Blount*"). Claims 1-4 were rejected under 35 U.S.C. § 103(a) as obvious over EP0222720A to Kallstrom ("*Kallstrom*") in view of *Sugahara* and *Shodai* or *Ishida*. Claim 7 and 10-12 were rejected under 35 U.S.C. § 103(a) as obvious over *Kallstrom* in view of *Sugahara* and *Shodai* or *Ishida* in further view of *Blount*. Claims 6, 8, 9 and 14 were indicated as allowable if written in independent form.

With regard to the rejection of claim 1, *Sugahara* discloses a coating composition comprising a silicate binder (such as water glass) and an inorganic phosphoric curing agent (such as a silicon polyphosphate) that slowly releases phosphoric acid into solution to prevent premature gelation and maintain viscosity for coating, painting, or dipping materials therein. While *Sugahara* discloses the addition of magnesium chloride in Example 7, *see* col. 33, ln. 43, the salt is used strictly for the **preparation** of the polyvalent metal silicate of the coating composition. After a double decomposition reaction of magnesium chloride and sodium silicate, a sodium salt (presumably sodium chloride) is **removed** by water washing, leaving only magnesium silicate. The magnesium silicate is then dried and pulverized for later use in forming the coating composition. As the coating composition does not in fact contain magnesium chloride, it is irrelevant whether *Shodai* or *Ishida* teach interchangeability of calcium chloride

with magnesium chloride as the composition disclosed in *Sugahara* does not include *any* alkali metal salt, and definitely not calcium chloride as expressly required by claim 1.

As the remaining claim rejections rely on this erroneous interpretation of the disclosure in

Sugahara, claim 2-4, 6-12 and 14 are also believed to be patentable.

Specifically with regard to the rejection of claim 7, the proposed combination lacks the requisite motivation to use dibasic sodium phosphate as suggested by the Examiner. The Examiner relied on *Blount* as disclosing that dibasic sodium phosphate is advantageous for lowering the pH and making a composition less flammable. This proposed motivation is legally deficient in two regards.

First, the motivation is only applicable to instances where lowering the pH would be advantageous. A *prima facie* case of obviousness requires that the motivation or suggestion be desirable, have some expectation of success, and not change the principle operation of the claimed invention. See MPEP § 2143.01. *Blount*, which includes a variety of organic bases in a complex polyamide silicate resin, may benefit from buffering of the pH. The claimed composition, however, involves a water glass and calcium chloride composition that would not benefit from buffering of the pH. As a result, the disclosure in *Blount* that dibasic sodium phosphate is useful as a buffer is insufficient to motivate use of the compound in the present invention as buffering is not desirable and would not have any expectation of success.

Second, *Blount* does not expressly teach that lowering the pH affects the flammability of a composition. Nevertheless, even if pH affected flammability, the present invention lacks flammability, with or without the inclusion of disodium phosphate. Thus, one of ordinary skill in the art would not be motivated to use dibasic sodium phosphate as there is no need to reduce flammability (the claimed invention is not flammable) and, even if one were motivated to reduce

flammability, the inclusion of dibasic sodium phosphate would not positively affect the flammability of the claimed invention.

With regard to the objection to claims 6, 8, 9 and 14, claims 6 and 8 have been rewritten in independent form.

In view of the foregoing amendments, the Examiner's reconsideration is requested and allowance of the present application is believed to be in order. If the Examiner believes a phone conference with Applicant's attorney would expedite prosecution of this application, she is respectfully requested to contact him at (315) 218-8515.

Respectfully submitted,

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By: 

George R. McGuire
Reg. No. 36,603

BOND, SCHOENECK & KING, PLLC
One Lincoln Center
Syracuse, New York 13202-8530
(315)218-8515